

REMARKS

This Response is made to the Official Action mailed March 11, 2008. Claims 1-18 are currently pending in this application. The subject matter of the claims is subject to a requirement for restriction and election under 35 U.S.C. §§121 and 372. Reconsideration and withdrawal of the requirements for restriction and election of species are respectfully requested in view of the following remarks.

Applicant is required to make an election among three allegedly distinct inventions, namely, Group I, covering claims 1- 5, 8-10, 12-18 drawn to an aerosol dentifrice; Group II, covering claims 6-7, drawn to an aerosol dentifrice formulation being a fluid mixture; and Group III, claim 11 drawn to an aerosol dentifrice.

In particular, the Action asserts that the "inventions listed as Groups I, II and III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding technical features for the following reasons: Groups I, II and III do not have a common technical feature that distinguishes the claims over the prior art. The common technical feature found in all groups is aerosol dentifrice with propellant . . ." allegedly taught by two pieces of art.

Applicant respectfully traverses the requirement for restriction initially because it does not comply with the unity of invention standard set by the PCT, and secondly, because it is improper under U.S. restriction practice since there would be no additional burden upon the Examiner to search all Groups together.

The standard applicable to the instant application is not one of restriction practice under U.S. guidelines, but one of unity of invention under the PCT. In the instant case, no lack of unity of invention was found by the International Searching Authority or the International Preliminary Examining Authority, and all claims were searched and examined as one invention. The question of unity of invention may be reexamined only within the scope of rules of the Patent Cooperation Treaty (35 U.S.C. §372(b)), and restriction requirements made according to U.S. practice, which are more restrictive than the PCT regulations, are in error. PCT Article 27 ("no national law shall require compliance with requirements relating to form or contents ... different from or additional to those which are provided for in this Treaty and the Regulations").

PCT Rule 13.1 states that there exists unity of invention if the international application relates "to one invention only or to a group of inventions so linked as to form a single general inventive concept." Clearly the general inventive concept which links the alleged various inventions here is their commonality as aerosol dentifrice formulations with a propellant. PCT Rule 13.2 states that unity of invention shall be fulfilled where there is a technical relationship among those inventions involving one or more of the same or corresponding technical features, where the technical feature defines the contribution that each of the claimed inventions makes

over the prior art. The special technical feature shared by each of the various Groups which the Examiner has deemed distinct is an aerosol dentifrice with a propellant. Since the specific formulations claimed herein are related to the same underlying technical features, there is unity of invention and a restriction requirement is improper.

Furthermore, in accordance with U.S. practice, M.P.E.P. §803 mandates two criteria for a proper restriction requirement: 1) the inventions must be independent or distinct as claimed; and 2) there must be a serious burden on the Examiner if restriction is not required.

It is urged that the above Groups are merely different embodiments of a single inventive concept for which a single patent should issue and do not constitute distinct inventions such as to require that the subject matter be prosecuted in separate patent applications.

"Independent", according to M.P.E.P. §802.01, means that "there is no disclosed relationship between the two or more subjects disclosed." The subject matter of Groups I, II and III are clearly related, having arisen from a singular research effort, as related to novel aqueous aerosol dentifrice formulations having a propellant and a particulate abrasive. Therefore, the Groups are not independent inventions within the meaning of §802.01. Furthermore, since the compounds have core formulation components there is not an undue burden on the Examiner with respect to searching the subject matter of the invention.

Therefore, in view of the foregoing and further in view of the interest of efficiency and cost savings to both Applicant and the PTO, reconsideration and withdrawal of the requirements for restriction and election are requested. However, Applicant provisionally elects, subject to the traverse set forth above, Group I, covering claims 1-5, 8-10 and 12-18 drawn to an aerosol dentifrice. In addition, Applicant elects as the species of a non-hydrocarbon propellant, dimethylether (DME) in claim 2, and the species of a hydrocarbon propellant, n-butane in claim 4. In the event the requirement is made final, Applicant hereby reserves the right to file one or more divisional applications directed to the non-elected subject matter.

In view of the above remarks, reconsideration and allowance of this application with claims 1-18 are earnestly solicited.

Respectfully Submitted,



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